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FEB 04 2008

OFFICE OF PETITIONS

In re Application of :
Wang Han YAP :
Application No. 10/511,774 : **DECISION ON PETITION**
Filed: October 18, 2004 :
Attorney Docket No. B-5555OCT 622252-9 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 27 2007, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed June 15, 2005, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on September 16, 2005.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. See MPEP 711.03(c)(II)(C) and (D). The instant petition lacks item three (3).

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137(b):

- (1) the delay in reply that originally resulted in the abandonment;
- (2) the delay in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application; and
- (3) the delay in filing a grantable petition pursuant to 37 CFR 1.137(b) to revive the application.

Currently, the delay has not been shown to the satisfaction of the Director to be unintentional for periods (1) and (2).

As to Period (1):

The patent statute at 35 U.S.C. § 41(a)(7) authorizes the Director to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition accompanied by either a fee of \$500 or a fee of \$50 **would not be granted where the abandonment** or the failure to pay the fee for issuing the patent **was intentional** as opposed to being unintentional or unavoidable." [emphasis added]. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), *reprinted in* 1982 U.S.C.C.A.N. 770-71. The revival of an intentionally abandoned application is antithetical to the meaning and intent of the statute and regulation.

35 U.S.C. § 41(a)(7) authorizes the Director to accept a petition "for the revival of an unintentionally abandoned application for a patent." As amended December 1, 1997, 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where, as here, there is a question whether the initial delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989); 37 CFR 1.137(b). Here, in view of the inordinate delay (two years) in resuming prosecution, there is a question whether the entire delay was unintentional. Petitioner should note that the issue is not whether some of the delay was unintentional by any party; rather, the issue is whether the entire delay has been shown to the satisfaction of the Director to be unintentional.

The question under 37 CFR 1.137(b) for period (1) is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unintentional. Accordingly, any renewed petition must clearly identify the party having the right to reply to avoid abandonment on September 16, 2005. That party, in turn must explain what effort(s) was made to further reply to the outstanding Office action and further, why no reply was filed. If no effort was made to further reply, then that party must explain why the delay in this application does not result from a deliberate course of action (or inaction). As Richard Berg (Berg) was the party having the right to reply at the date of abandonment, Berg should explain why this application became abandoned while it was under his control and what efforts were made to further reply and with whom this matter was discussed. When did Berg and Wang Han Yap (Yap) become aware of the abandonment of this application? Additionally, Berg and Yap must explain the circumstances surrounding the discovery of the abandonment of this application almost two years after the mailing of the Notice of Abandonment.

Copies of any correspondence relating to the filing, or to not filing a further reply to the outstanding Office action are required from responsible person(s), Wang Han Yap and whoever else was involved with this application at the time of abandonment. Statements are required from the responsible person(s) having firsthand knowledge of the circumstances surrounding the lack of a reply to the outstanding Office action. As the courts have made clear, it is pointless for the USPTO to revive a long abandoned application without an adequate showing that the delay did not result from a deliberate course of action. See Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005); Lumenyte Int'l Corp. v. Cable Lite Corp., Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional).

As to Period (2):

Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). See MPEP 711.03(c).

The language of both 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and, furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well as in filing the petition seeking revival, must have been, without qualification, "unintentional" for the reply to now be accepted on petition. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent

abuse and injury to the public. *See* H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner could require applicants to act promptly after becoming aware of the abandonment"). The December 1997 change to 37 CFR 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application. *See* Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997), which clearly stated that any protracted delay (here, two years) could trigger, as here, a request for additional information. As the courts have since made clear, a protracted delay in seeking revival, as here, requires a petitioner's detailed explanation seeking to excuse the delay as opposed to USPTO acceptance of a general allegation of unintentional delay. *See* Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633, at 1637-8 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005) at *21-*23. Statements are required from any and all persons and the responsible person(s) having firsthand knowledge of the circumstances surrounding the protracted delay, after the abandonment date, in seeking revival.

As noted in MPEP 711.03(c)(II), subsection D, in instances in which such petition was not filed within 1 year of the date of abandonment of the application, applicants should include:

- (A) the date that the applicant first became aware of the abandonment of the application; and
- (B) a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant.

In either instance, applicant's failure to carry the burden of proof to establish that the "entire" delay was "unavoidable" or "unintentional" may lead to the denial of a petition under 37 CFR 1.137(b), regardless of the circumstances that originally resulted in the abandonment of the application. *See also* New York University v. Autodesk, 2007 U.S. DIST LEXIS, U.S. District LEXIS 50832, *10 -*12 (S.D.N.Y. 2007)(protracted delay in seeking revival undercuts assertion of unintentional delay).

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. *See* In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the \$510 extension of time fee submitted with the petition on September 27, 2007 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

Any renewed petition may be addressed as follows:

By Mail: Mail Stop PETITION
 Commissioner for Patents
 P. O. Box 1450
 Alexandria, VA 22313-1450

By hand: U. S. Patent and Trademark Office
 Customer Service Window, Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

The centralized facsimile number is (571) 273-8300.

Correspondence regarding this decision may also be filed through the electronic filing system of the USPTO.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-4231.



Michelle R. Eason
Paralegal Specialist
Office of Petitions

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Wang Han YAP)	Examiner: Vanessa Mary GIRARDI
)	
Serial No.:	10/511,774)	Art Unit: 2833
)	
Filed:	October 18, 2004)	Our Ref: B-5555PCT 622252-9/RPB/RP
)	
For:	"EXTENSION SOCKET DEVICE WITH A CORD STORAGE AND DISPENSING SYSTEM")	Re: <i>Petition under 37 C.F.R. §1.137(b)</i>
)	

PETITION UNDER 37 C.F.R. §1.137(b)

TO REVIVE AN UNINTENTIONALLY ABANDONED APPLICATION

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant respectfully petitions under 37 C.F.R. §1.137(b) to revive the above-referenced application which unintentionally went abandoned in February of 2006 for failure to submit a response to the last issued Office Action.

The present petition includes a response to the last Office Action issued in the case together with a petition for a three month extension of time pursuant to 37 C.F.R. 1.136(a). The amount of \$510.00 for the fee set forth in 37 C.F.R. 1.17(a)(3) has been paid concurrently with this electronic submission.

Pursuant to 37 C.F.R. §1.137(b), Applicant states that the abandonment of the above-referenced application was unintentional. Grant of the present petition and revival of the above-referenced application are therefore respectfully requested. The amount of \$750.00 for the petition fee set forth in 37 C.F.R. §1.17(m) has also been paid concurrently with this electronic submission.

Adjustment date: 02/04/2008 CKHLOK
09727/2007 INTEFSW 00006053 120415 10511774
02 FC:2253 510.00 CR

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this document is being transmitted to the
Patent and Trademark Office via electronic filing.

Respectfully submitted,

September 27, 2007

(Date of Transmission)

A handwritten signature in black ink, appearing to read 'Wang Han YAP', with a vertical line extending downwards from the signature.

Wang Han YAP

UNITED STATES PATENT & TRADEMARK OFFICE
Washington, D.C. 20231

REQUEST FOR PATENT FEE REFUND																																																					
1 Date of Request: <u>2-1-08</u>		2 Serial/Patent # <u>10/511779</u>																																																			
3 Please refund the following fee(s): <table border="1" style="width:100%; border-collapse: collapse; margin-top: 5px;"> <tr><td style="width: 5%;"></td><td style="width: 45%;">Filing</td><td style="width: 15%;">4 PAPER NUMBER</td><td style="width: 15%;">5 DATE FILED</td><td style="width: 20%;">6 AMOUNT</td></tr> <tr><td></td><td>Amendment</td><td></td><td></td><td>\$</td></tr> <tr><td><input checked="" type="checkbox"/></td><td>Extension of Time</td><td></td><td></td><td>\$ <u>510.00</u></td></tr> <tr><td></td><td>Notice of Appeal/Appeal</td><td></td><td></td><td>\$</td></tr> <tr><td></td><td>Petition</td><td></td><td></td><td>\$</td></tr> <tr><td></td><td>Issue</td><td></td><td></td><td>\$</td></tr> <tr><td></td><td>Cert of Correction/Terminal Disc.</td><td></td><td></td><td>\$</td></tr> <tr><td></td><td>Maintenance</td><td></td><td></td><td>\$</td></tr> <tr><td></td><td>Assignment</td><td></td><td></td><td>\$</td></tr> <tr><td></td><td>Other</td><td></td><td></td><td>\$</td></tr> </table>		Filing	4 PAPER NUMBER	5 DATE FILED	6 AMOUNT		Amendment			\$	<input checked="" type="checkbox"/>	Extension of Time			\$ <u>510.00</u>		Notice of Appeal/Appeal			\$		Petition			\$		Issue			\$		Cert of Correction/Terminal Disc.			\$		Maintenance			\$		Assignment			\$		Other			\$	7 TOTAL AMOUNT OF REFUND <u>510.00</u> \$ <u>0.00</u>		
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